Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN T. STOYCOS and EWIN MICHAEL KISER

MAILED

Appeal No. 2004-0896
Application No. 09/751,774

MAR 3 1 2004

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

ON BRIEF

Before WALTZ, KRATZ and PAWILOWSKI, Administrative Patent Judges.

KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-24, which are all of the claims pending in this application.

BACKGROUND

Appellants' invention relates to a method of accessing a study record taken during a cardiac catheterization procedure. The method can allow for the real time access to displayed data on a plurality of workstations during a cardiology procedure. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method of accessing a study record taken during a cardiac catherization procedure, the procedure being conducted in a cardiac catherization lab, comprising the acts of:

(a) inserting at least one catheter into a patient comprising a heart, catheters terminating in a position proximate to the heart and comprising one or more sensors configured to sense data from the heart;

(b) stimulating the heart with electrical signals from the catheter;

(c) sensing data from the heart;

(d) transmitting the data from the sensors to a data collection device;

(e) transmitting the data from the data collection device to a central publisher;

(f) replicating the data;

(g) transmitting the replicated data from the central publisher to a plurality of client workstations; and

(h) simultanously displaying the data on the plurality of client workstations.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

| Budd et al. | 5,662,108 | Sep. 02, 1997 |
| Soukal | 6,035,328 | Mar. 07, 2000 |

Claims 1-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Soukal in view of Budd.

We refer to the brief and to the answer for a complete exposition of the opposing viewpoints expressed by appellants and the examiner concerning the issues before us on this appeal.

DECISION AND OPINION

We reverse.

A central question before us is whether the examiner's assertion of inherency with respect to the Soukal reference is reasonable. We answer that question in the negative since the examiner has not provided a sufficient basis in fact and/or technical reasoning to reasonably support the examiner's assertion (answer, page 4) concerning the allegedly inherent performance of the claimed process steps, including the replicating step, as necessarily flowing from the teachings of the applied prior art. See Ex parte Levy, 17 USPQ 1461, 1464 (Bd. Pat. App. & Int. 1990).[1]

Concerning this matter, we observe that Soukal describes a medical therapeutic and/or diagnostic system including at least one operating means including computing means allocated thereto, and a control means communicating therewith for controlling the operation. Exemplary therapeutic and/or diagnostic systems described as prior art in Soukal (column 1, lines 13-18) include

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[1] The examiner's obviousness position advanced in the rejection before us hinges on the examiner's assertion of inherency with respect to Soukol's disclosed therapeutic and diagnostic system.

X-ray and shock wave systems.   Soukal (column 1, lines 40-47)

teaches that:

> at least a part of the operating and/or processing
> data previously stored in the computing unit of the
> operating means, i.e., the system's specific technical
> software, is not stored there anymore, but rather is
> only implemented in the control means, which delivers
> the software to the operating means only as needed,
> such as in the startup of the operating means or the
> like.

In the drawing figure, Soukal depicts an arrangement

employing a number of operating units, including intranet

connected units and external operating means (11) that require

use of a public network, i.e., the Internet, for connection.   At

column 3, lines 29-34, Soukal further provides that:

> [t]he communication between the operating units **4**
> and **6** and the control unit **8** ensues via an HTTP
> protocol, so that the control unit **8** acts as an HTTP-
> server, which places the necessary operating and/or
> processing data, i.e., the respective software, at the
> operating unit side, at one's disposal as needed.

From the above passages, it is clear that Soukal is

concerned with software exchange and storage for use in the

operating means as argued by appellants (brief, page 7, first

full paragraph), not data acquired during a test procedure.   The

examiner refers to column 1, lines 54-56 of Soukal for a teaching

of data transmission.   However, as evident from the passages

reproduced above, Soukal use the term "exchange of data" as that

term relates to operating or processing data (software).

Moreover, the examiner (answer, page 4) acknowledges that

applicants provide more detail in disclosing their system than

does Soukal. Consequently, the examiner has not shown that

Soukol describes a control and operating system identical with or

substantially the same as appellants' system so as to support the

examiner's position that operating Soukal's system necessarily

results in steps being performed that correspond to the data

handling steps (d) through (h) of claim 1.[2]

The examiner, in relying on a theory of inherency, must

provide a basis in fact and/or technical reasoning to reasonably

support the determination that the allegedly inherent

characteristics necessarily flow from the teachings of the

applied prior art. See In re Robertson, 169 F.3d 743, 745, 49

USPQ2d 1949, 1950-51 (Fed. Cir. 1999). The examiner has not

provided persuasive support for an inherency theory. Inherency

cannot be established based on conjecture and/or probabilities or

possibilities. See In re Oelrich, 666 F.2d 578, 581, 212 USPQ

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[2] The examiner additionally relies on Budd to show a
catheterization procedure. The examiner does not rely on Budd to
suggest appellants' data processing method steps.

323, 326 (CCPA 1981); <u>Ex parte Skinner</u>, 2 USPQ2d 1788, 1788-1789

(Bd. Pat. App. & Int. 1986).

On this record, we will not sustain the examiner's

rejection.

REMAND

We note that appellants refer to prior techniques in the

Background of Related Art section of their specification,

including the need for consultation with multiple clinicians and

the use of techniques, such as fax machines, to communicate data

from an electrophysiology (EPS) study to clinicians at remote

sites (specification, page 4). Prior to final disposition of

this application and if not already investigated, the examiner,

with appellants' help, should determine if the prior techniques

referred to in the specification represent prior art to

appellants' claimed invention. If so, the examiner should

determine the full extent of those prior art teachings.

Thereafter, the examiner should consider whether or not those

prior art teachings in combination with Budd taken with any other

known prior art, including Soukal, would have led (provided both

the incentive and a reasonable expectation of success) one of

ordinary skill in the art to transmit, replicate and display

sensed data obtained from a patient's heart via such an EPS

study, as here claimed.

CONCLUSION

The decision of the examiner to reject claims 1-24 under

35 U.S.C. § 103(a) as being unpatentable over Soukal in view of

Budd is reversed.

REVERSED/REMANDED

THOMAS A. WALTZ   )
Administrative Patent Judge   )
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) BOARD OF PATENT
PETER F. KRATZ   )   APPEALS
Administrative Patent Judge   )   AND
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PFK/sld

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